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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,135	01/15/2002	Yossi Gross	B0250/7010 SJH	4819

23628 7590 07/10/2003

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EXAMINER	
SZMAL, BRIAN SCOTT	
ART UNIT	**PAPER NUMBER**
3736	4

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/047,135	GROSS ET AL.	
	Examiner	Art Unit	
	Brian Szmal	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,13,14,25-30,41,58-61 and 90-123* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *112-121* is/are allowed.

6)☒ Claim(s) *1,25,41,58,90-94,103,104,111,122 and 123* is/are rejected.

7)☒ Claim(s) *2,4,13,14,26-30,59-61,64,95-102 and 105-110* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/413,272* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Double Patenting

1. Claims 90 and 91 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 122 and 123. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 31 of U.S. Patent No. 6,354,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because the issued claim is in a broader language than the current claim.

4. Claims 4 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32 and 35 of U.S. Patent No. 6,354,991. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the issued claims are in a broader language than the current claims.

5. Claim 41 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,354,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claim is in a broader language than the issued claim.

6. Claim 58 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 40 of U.S. Patent No. 6,354,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claim is written in a broader language than the issued claim.

7. Claims 90, 91, 122 and 123 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 69 of U.S. Patent No. 6,354,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are written in a broader language than the issued claim.

8. Claim 111 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 26 of U.S. Patent No. 6,354,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claim is written in a broader language than the issued claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 41, 90, 91, 103, 104, 111, 122 and 123 are rejected under 35 U.S.C. 102(b) as being anticipated by Carman ('902).

Carman discloses an incontinence treatment and further discloses at least one electrode in electrical contact with a pelvic muscle; a control unit which receives EMG data from the electrode, and responsive to the data, applying an electrical waveform to stimulate the muscle to contract, thereby inhibiting urine flow; determining a rate of change for the signals; and applying the waveform when the rate of change is above a threshold rate and withholding the waveform when the rate of change is below the threshold. See Column 1, lines 13-41 and 66-68; and Column 2, lines 1-10.

Allowable Subject Matter

11. Claims 2, 4, 13, 14, 26-30, 59-61, 64, 95-102 and 105-110 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: Claims 112-121 are allowable since no prior art could be found concerning or

suggesting receiving a pressure measurement signal indicative of abdominal stress; receiving a strain measurement signal indicative of abdominal stress; and using the received signals to determine if a waveform needs to be applied to inhibit urine flow.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmal whose telephone number is (703) 308-3737 and group fax number is (703) 308-0758. The examiner can normally be reached on Monday-Friday, with second Fridays off.

BS
July 2, 2003

MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
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